

REMARKS

Status of the Claims

Claims 1-7 and 10 are currently pending in the application and subject to a Restriction Requirement. (*See*, Office Communication of July 28, 2006, 2006, at page 2). Claims 8 and 9 have been cancelled herein without prejudice or disclaimer. No new matter has been entered as a result of the present amendment of the claims.

Restriction Requirement/Election of Species

Claims 1-10 are subject to a Restriction Requirement under PCT Rule 13.1 for reciting inventions or groups of inventions which are not so linked +as to form a single general inventive concept. (*See*, Office Communication of July 28, 2006, at page 2, hereinafter, "Office Communication"). Claims 8 and 9 have been cancelled herein without prejudice or disclaimer, thus obviating the restriction as to claims 8 and 9.

The Examiner has required election in the present application between:

Group I, claims 1-7 and 10, drawn to a method for examining cancer cells comprising binding cancer cells separated from the body that express the SF-25 antigen to immunomagnetic beads using an anti-SF-25 antibody or antigen binding fragment thereof, collecting the beads by magnetic force, and examining the cancer cells bound to the beads by examining the cells' nucleic acids;

Group II, claim 8, drawn to a reagent for examining cancer cells that express SF-25 using magnetic beads having an anti-SF-25 antibody immobilized thereto; and

Group III, claim 9, drawn to a method for producing a reagent as in Group II. (*Id.* at page 2).

The Examiner further reminds Applicants that because the present Restriction is between a product and its process of use, where Applicants elect claims directed to the product, and a product is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Such process claims that depend from or otherwise include all the limitations of the patentable product are entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Furthermore, in the event of rejoinder, Applicants understand that the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims must be fully examined for patentability according to the provisions of M.P.E.P. § 1.104.

For the purpose of continuing prosecution of the present application, Applicants elect, with traverse, Group I, claims 1-7 and 10.

Furthermore, the Examiner states that the inventions listed as Groups I-III do not relate to a single general inventive concept because the inventive concept lacks the same or corresponding special technical features. (*Id.* at page 3). Specifically, the Examiner states that the special technical feature appears to be immunomagnetic beads comprising an SF-25 antibody for binding to and examining cancer cells that express the SF-25 antigen. The Examiner cites to Park et al., *J. Cancer Res. Clin. Oncol.*, 127:489-494, 2001, and Takahashi et al., *Cancer Res.*, 48:6573-6579, 1988, as disclosing immunomagnetic beads comprising an antibody specific for a

cancer antigen expressed by cancer cells and using said beads to separate and isolate said cancer cells that express said antigen. However, Park et al. do not disclose an antibody directed against SF-25. The Examiner cites to Takahashi et al. for this missing element.

Although the Examiner cites the disclosures of Park et al., as modified by the disclosure of Takahashi et al., to establish a *prima facie* case of obviousness, the cited references considered either individually or in combination, do not disclose or suggest each and every limitation of the presently claimed invention. For instance, the disclosure of Park et al. discuss using model cells which are grown in tissue culture for the ultimate purpose of performing RT-PCR on the DNA of the cells thus isolated. However, claim 1 is directed to binding cancer cells which have been separated from the body. The specification at, for instance, pages 7-8 and Example 4, disclose that the cells are to be isolated from a body.

Thus, since the cited references do not disclose or suggest all of the limitations of the presently claimed invention, the Examiner has not established a *prima facie* case of obviousness, at least with respect to claim 1, and those claims depending therefrom.

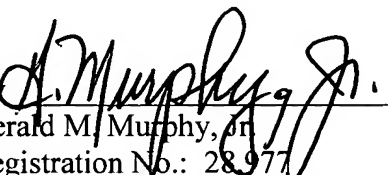
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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